Remarks

Applicants thank the Examiner for extending to the undersigned attorney the courtesy of an in-person interview on Friday, January 17, 2003 and a telephonic interview on Thursday, February 6, 2003. Agreement was not reached during either interview. At the January 17 interview the 35 USC §112 and 35 USC §102 rejections and the cited reference to U.S. Patent No. 3,639,315 (Rodriguez) were discussed. The Examiner also gave the undersigned attorney citations to footnote 6 of *Atlantic Thermoplastics Co. Inc. v. Faytex Corp.*, 23 USPQ 2d 1481 (1486), to *Ex parte Tanksley*, 26 USPQ 2d 1384 (BPAI, 1991) and to *Purdue Research Foundation v. Watson*, 1959 CD 124, 122 USPQ 445 (DCDC 1958), affirmed 120 USPQ 521 (CADC, 1959). These decisions were said by the Examiner to support rejections under 35 USC § 112, second paragraph of claims containing the phrases "obtainable" or "preparable by".

In the telephonic interview the undersigned attorney advised the Examiner that a further amendment would be submitted. The Examiner mentioned that another attorney had recently given him a copy of a January 17, 2003 USPTO memorandum (the "Memorandum") from the USPTO Deputy Commissioner for Patent Examination Policy concerning rejections made under 35 U.S.C. § 112, second paragraph. Applicants' attorney obtained a copy of the Memorandum from the USPTO Special Program Law Office. The Memorandum, entitled "Advance notice of changes to MPEP § 2173.02 clarifying Office policy with respect to rejections made under 35 U.S.C. § 112, second paragraph in view of the Supreme Court holding in *Festo Corp. v. Shoketsu Kinozoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831, 62 USPQ 2d 1705 (2002)", is discussed below.

Applicants have amended claims 1 and 4 to recite that "the first component contains a sufficient number of isocyanate groups and the second component contains a sufficient number of hydroxyl groups so that a mixture of the first component and second component has a processing time from 10 minutes to 6 hours at room temperature". Antecedent basis for this amendment can be found in the Written Description at e.g., page 7, line 24 through page 8, line 8. Following entry of this amendment claims 1-10 will be pending in this application.

Rejection under 35 USC §112, second paragraph

The rejection of claims 1-10 under 35 USC § 112, second paragraph was based on *Ex Parte Wu*, *Ex parte Steigerwald*, *Ex Parte Hall* and *Ex Parte Hasche*, decisions that all involve or refer to "such as" clauses in claims. The Memorandum makes clear that reliance

on these cited decisions constitutes a *per se* rule that should no longer be used as the basis for a rejection under 35 USC § 112, second paragraph[1]. Reliance on the cited decisions in *Atlantic Thermoplastics*, *Ex parte Tanksley* and *Purdue Research Foundation* likewise constitutes a *per se* rule that should not be used as the basis for a rejection under 35 USC § 112, second paragraph. The cited footnote 6 in *Atlantic Thermoplastics* discussed *Cochrane v. Badische Anilin & Soda Fabrik*, 111 U.S. 293 (1884), a decision dated well prior to the present 1952 patent act and involving a so-called "product-by-process claim" to an old article. Applicants are not claiming an old article and have not employed "product-by-process" claim language in independent claims 1 or 4. *Ex parte Tanksley* involved claims for tomato cDNA clones that were found to be indefinite under 35 USC 112, second paragraph because the claimed clones were characterized only in a manner that read on clones of the prior art and were not characterized in a more precise manner such as base sequence or function. Applicants' claims have not been characterized in a manner that reads on paint systems or processes of the prior art. *Purdue Research Foundation* involved a claim reciting, *inter alia*, an "approximate" chemical formula and a melting point range that "was not determined with a degree of accuracy to make it, by the standards of the organic chemistry art, an identifying characteristic". Applicants have not recited an approximate chemical formula or insufficient identifying characteristics. As mentioned in applicants' Response filed January 9, 2003, it is customary in the alkyd resin art to describe an alkyd resin in terms of the ingredients from which it conveniently might be made. Those skilled in the art will be well aware that the recited alkyd resin could be made using other reaction schemes so long as the end result provides an alkyd resin containing moieties corresponding to those that would be obtained using the recited ingredients. Applicants' claims apprise those of ordinary skill in the art of the claims' scope and "[serve] the notice function required by 35 U.S.C. § 112, second paragraph by providing clear warning to others as to what constitutes infringement of the patent", thus meeting the standard set out in the Memorandum. Claims 1-10 will readily be understood by those skilled in the art and are not indefinite. The rejection of these claims under 35 USC §112 should be withdrawn.

[1] "The mere use of the phrase "such as" in the claim does not by itself render the claim indefinite. Office policy is not to employ *per se* rules to make technical rejections."

Rejection under 35 USC §102

The rejection of claims 1-10 under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,639,315 (Rodriguez) should likewise be withdrawn. Applicants' two-component paint systems harden shortly after the first component (the hydroxyl-containing resin) is combined with the second component (the isocyanate). As recited in claims 1 and 4, "the first component contains a sufficient number of isocyanate groups and the second component contains a sufficient number of hydroxyl groups so that a mixture of the first component and second component has a processing time from 10 minutes to 6 hours at room temperature". Rodriguez does not disclose such a paint system. Rodriguez's one-component paint systems are stable when stored as dispersions, and do not harden until they are applied as a coating and exposed to air.

Conclusion

Applicants' claims provide clear warning to others as to what constitutes infringement, and should not be rejected under 35 USC §112. Applicants' claims are not anticipated by Rodriguez, and should not be rejected under 35 USC §102. The Examiner is requested to telephone the undersigned attorney if any issues remain unresolved.

Respectfully submitted,

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